

R E M A R K S

Claims 1, 2, 5-23, 25-27, 29-34, 36 and 38-40 are pending in this application. Support for the changes to claims 1 and 17 regarding the "flexible substrate" element is found at page 10 of the specification. Support for the changes to claims 7 and 17 regarding the phrase "containing glycidyl groups" is found at page 30 of the specification.

Allowable Claims

Claims 9-11, 18, 19, 22, 30, 31 and 39 have been indicated as being allowable, and presently stand rejected merely because these claims depend upon a rejected base claim.

Removal of Issues under 35 U.S.C. 102(b)

Claims 7, 8, 12, 17 and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sei '137 (USP 5,523,137).

It is submitted that this rejection has been removed in view of the following.

In response to the above-noted rejection, it is noted that claims 7 and 17 have been amended so as to recite that component (B) contains glycidyl groups. Therefore, consistent with the remarks stated in the first full paragraph at page 4 of the Office

Action of June 26, 2003, it is submitted that these independent claims 7 and 17, as well as claims 8, 12 and 20 depending therefrom, now patentably define over Sei '137. Consequently, for the same reasons that the previous rejection based on Sei '137 against claim 1 was removed, the present rejection should also be removed. It is submitted that all of these claims patentably define over Sei '137 for the same reasons it was agreed that claim 1 defines over this document. Therefore, it is requested that this rejection be withdrawn.

Issues under 35 U.S.C. 102(e) and 103(a)

Claims 1, 7, 8, 12-14, 17, 20 and 38 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Hashimoto '988 (USP 5,863,988).

Claim 1 has been rejected under 35 U.S.C. § 102(a) as being anticipated by Lee '566 (USP 5,955,566).

Claims 5, 6, 15, 16, 23, 25-29, 32, 34 and 36 have been rejected under 35 U.S.C. § 102(a), or in the alternative under 35 U.S.C. § 103(a), as being unpatentable over Hashimoto '988.

Claims 21 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto '988.

Claim 2 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee '566 in view of JP '973 (Japanese Patent Application No. 08-301973).

Claim 40 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto '988 in view of Chem. Abstract Index Registry No. 2461-46-3, biphenyl diepoxide.

Removal of Rejections based on Hashimoto '988

It is submitted that all of the above-noted rejections based completely on, or in part on, Hashimoto '988 should be withdrawn as Applicants are submitting Priority Documents, which perfect the claim to priority under 35 U.S.C. 119, so as to remove this document as prior art. Hashimoto '988 has an effective prior art date under 35 U.S.C. 102(e)/103(a) of December 18, 1996. The submission of Verified English Translations of the three Priority Documents for the present application establishes a priority date of, at the latest, February 20, 1996 for all of the presently pending claims, which each finds full support in at least one of the Priority Documents.

These Priority Documents include:

- (1) Japanese Patent Application No. 8-30500 filed February 19, 1996;
- (2) Japanese Patent Application No. 8-30501 filed February 19, 1996, and
- (3) Japanese Patent Application No. 8-31782 filed February 20, 1996.

In view of the above, it is submitted that all rejections based at least in part on Hashimoto '988 should be withdrawn.

Remaining Rejections of Claims 1 and 2

Claim 1 has been rejected as being anticipated under 35 U.S.C. 102(e) by Lee. Claim 2 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Lee '566 in view of JP '973. These rejections should be withdrawn in view of the following reasons.

Claim 1 recites that the flexible substrate is formed of an organic-type material. In contrast, Lee '566 only includes examples wherein the described thermosetting polymers are disposed on "silicone release paper" (note column 6, lines 45-48). Lee '566 fails to disclose or suggest the use of an organic-type substrate as employed in the present invention. Additionally, Lee '566 discloses "thermosetting" polymers, which contrast with the thermoplastic resins employed in the present invention.

Consequently, significant patentable distinctions exist between the present invention and Lee '566, such that the rejections based on Lee '566 should both be withdrawn.

In addition to the above, it is noted that claim 2 depends from claim 1, such that all of the above-noted distinctions over Lee '566 also apply with regard to claim 2. Further, JP '973 is farther removed from the present invention than Lee '566 so as to fail to make up for the deficiencies of Lee '566. Even if JP '973 is hypothetically combined with Lee '566, the resulting combined hypothetical disclosure fails to describe or suggest the adhesive sheet of the present invention. Further still, both Lee '566 and JP '973 fail to disclose the effect of the combination of elements recited in claim 2, which results in advantageously high dimensional accuracy properties. High dimensional accuracy prevents curling of the semiconductor connecting flexible substrate, which is one of the most important properties and difficult problems overcome by the present invention. Note the paragraphs bridging pages 36 and 37, as well as Table 4 in the specification. The dimensional accuracy properties are also discussed at the paragraph bridging pages 12-13, as well as at page 20, lines 19-26, of the specification. Lee '566 fails to provide any basis for a motivation to one skilled in the art to obtain these advantageous properties.

In view of the above, it is submitted that significant patentable distinctions exist between claims 1 and 2 in the above-discussed documents, such that the above-noted rejections should be withdrawn.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Andrew D. Meikle (Reg. No. 32,868) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By


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Attachments: Copies of Priority Documents